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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,193	01/06/2006	Johannes Hubertus Wieringa	2003.796US	7506

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EXAMINER
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JARRELL, NOBLE E

ART UNIT	PAPER NUMBER
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1624

NOTIFICATION DATE	DELIVERY MODE
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11/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/564,193	<b>Applicant(s)</b> WIERINGA ET AL.	
	<b>Examiner</b> NOBLE JARRELL	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-13 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Response to Arguments***

1. The rejections under 35 U.S.C. 102 and 103 have been overcome by the amendment filed 8 October 2008.
2. The petition filed 8 October 2008 was granted 14 January 2009.
3. Claims 10-13 are pending in the instant application and are being examined in the current office action. Claim 10 is withdrawn from consideration.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Newly added claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van der Burg (US 4062848, issued 13 December 1977, cited previously) in view of Pizey (*Synthetic Reagents*, Volume 6, **1985**, pages 270-275 and 372-414) and Collins (*Methods for Obtaining Optically Active Compounds*, Chirality in Industry, **1992**, cited in IDS).

### ***Determining the scope and contents of the prior art***

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Van der Burg teaches the synthesis of mirtazapine by the reaction of 1-(3-hydroxymethylpyridyl-2)-2-phenyl-4-methyl-piperazine (3.25 grams) and 6.5 milliliters (mL) of concentrated sulfuric acid (example I, column 10, line 17 to column 11, line 31). The weight ratio of sulfuric acid (the dehydration agent) to the substrate [1-(3-hydroxymethylpyridyl-2)-2-phenyl-4-methyl-piperazine] is 2. The product is recrystallized in petroleum ether. Van der Burg also teaches that polyphosphoric acid (PPA), phosphorous pentoxide, and sulfuric acid are each dehydrating agents (column 2, lines 1-15). This teaching says that these three dehydration agents are equivalent.

Pizey teaches several concepts. The first concept is the use of cosolvents is required when the proportion of PPA to substrate is reduced (normally the proportion is 10-30 times the substrate). One such cosolvent listed is sulfolane, an aprotic polar solvent (page 373). The second concept is that PPA contains phosphorous pentoxide (page 374). This second concept teaches that when PPA is used as dehydration agent, phosphorous pentoxide is also active.

Collins teaches recrystallization is a common technique in organic chemistry (page 20, section 1.2.2.1).

***Ascertaining the differences between the prior art and the claims at issue***

In the current set of claims, the dehydration process of claims 11-13 is done with polyphosphoric acid without solvent, PPA in the presence of either *N*-methylpyrrolidinone or dimethylformamide, or phosphorous pentoxide in the presence of either *N*-methylpyrrolidinone or dimethylformamide.

Van der Burg teaches the preparation of mirtazapine with concentrated sulfuric acid as a dehydration agent. Van der Burg does not teach the explicit preparation of the (*S*)-enantiomer of mirtazapine.

Pizey teaches that dehydration reactions utilizing PPA (and phosphorous pentoxide) where the ratio of dehydration agent to substrate is less than 10 to 1, a cosolvent is required. Pizey does not teach the synthesis of mirtazapine.

***Resolving the level of ordinary skill in the pertinent art***

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Those of relative skill in the art are those with level of skill of the authors of the references cited to support the examiner's position (MD's, PhD's, or those with advanced degrees and the requisite experience in preparation of mirtazapine).

***Considering objective evidence indicating obviousness or nonobviousness***

System a) of claim 11 is rendered obvious by Van der Burg because the reference teaches the dehydration of a precursor to mirtazapine with an equivalent dehydration agent. Van der Burg states that sulfuric acid and PPA are equivalents in terms of dehydrating agents. In addition, the weight ratio of PPA to substrate is 2, which is less than 2.5:1. System b) of claim 11 and system c) of claim 11 and claim 13 are obvious because Pizey teaches that when the ratio of PPA (which contains phosphorous pentoxide) is less than ten to one, a cosolvent is required. The two cosolvents listed in the claims, *N*-methylpyrrolidinone and dimethylformamide, are both considered polar aprotic solvents. The use of these solvents in the dehydration process is considered obvious because it is considered routine experimentation to use different solvents in a reaction (optimization of conditions). Claim 12 is rendered obvious by Van der Burg because it would be obvious to purify a racemic mixture of products in order to determine which enantiomer has greater effectiveness as an antihistaminic compound (see abstract). Recrystallization is considered routine to obtain specific enantiomers of a compound (Collins, page 20, section 1.2.2.1).

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-

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MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOBLE JARRELL whose telephone number is (571)272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/  
Examiner, Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**